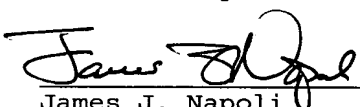




1FEN 1712

PATENT--NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                 |   |  |
|---------------------------------|---|--|
| Applicants:                     | ) | I hereby certify that this   |
|                                 | ) | paper is being deposited   |
| DIETER HERMELING ET AL.         | ) | with the United States   |
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| Serial No.: 10/561,685          | ) | cient postage, as first  |
|                                 | ) | class mail, in an envelope   |
| Filed: December 22, 2005        | ) | addressed to:  |
|                                 | ) | Mail Stop Amendment  |
| For: (METH)ACRYLIC ACID ESTERS  | ) | Commissioner for Patents   |
| OF ALKOXYLATED UNSATURATED      | ) | P.O. Box 1450  |
| POLYOL ETHERS, AND PRODUCTION   | ) | Alexandria, VA 22313-1450  |
| THEREOF                         | ) |  |
|                                 | ) | Dated: July 13, 2006   |
| Attorney Docket No. 29827/41757 | ) |  |
|                                 | ) |  |
| Group Art Unit: 1712            | ) | James J. Napoli  |
|                                 | ) | Registration No. 32,361  |
| Examiner: Unassigned            | ) | Attorney for Applicants  |

TRANSMITTAL OF ENGLISH-LANGUAGE TRANSLATION OF  
THE INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

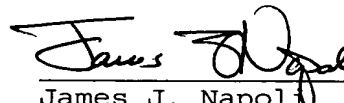
Sir:

Applicants hereby submit an English-language translation of the International Preliminary Examiner Report issued in connection with PCT/EP2004/007077, from which applicants claim priority.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By



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Chicago, Illinois 60606  
(312) 474-6300

Chicago, Illinois  
July 13, 2006

**Translation**

**PATENT COOPERATION TREATY**

**PCT**

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

|  |   |   |
|--|---|---|
| Applicant's or agent's file reference<br><b>0000054671</b>                   | FOR FURTHER ACTION<br>See Form PCT/IPEA/416                     |   |
| International application No.<br><b>PCT/EP2004/007077</b>                    | International filing date (day/month/year)<br><b>30.06.2004</b> | Priority date (day/month/year)<br><b>10.07.2003</b> |
| International Patent Classification (IPC) or national classification and IPC |   |   |
| Applicant<br><b>BASF AKTIENGESELLSCHAFT</b>                                  |   |   |

|   |              |   |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
|---|--------------|---|-------------------------------------|-----------|---------------------|-------------------------------------|------------|----------|--------------------------|-------------|--|--------------------------|------------|----------------------------|-------------------------------------|-----------|---|-------------------------------------|------------|-------------------------|--------------------------|-------------|--|--------------------------|--------------|---|
| <p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>6</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p> |              |   |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <p>4. This report contains indications relating to the following items:</p> <table border="0"> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>   |              |   | <input checked="" type="checkbox"/> | Box No. I | Basis of the report | <input checked="" type="checkbox"/> | Box No. II | Priority | <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability | <input type="checkbox"/> | Box No. IV | Lack of unity of invention | <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement | <input checked="" type="checkbox"/> | Box No. VI | Certain documents cited | <input type="checkbox"/> | Box No. VII | Certain defects in the international application | <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |
| <input checked="" type="checkbox"/>   | Box No. I    | Basis of the report   |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input checked="" type="checkbox"/>   | Box No. II   | Priority  |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input type="checkbox"/>  | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input type="checkbox"/>  | Box No. IV   | Lack of unity of invention  |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input checked="" type="checkbox"/>   | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input checked="" type="checkbox"/>   | Box No. VI   | Certain documents cited   |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input type="checkbox"/>  | Box No. VII  | Certain defects in the international application  |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |
| <input type="checkbox"/>  | Box No. VIII | Certain observations on the international application   |                                     |           |                     |                                     |            |          |                          |             |  |                          |            |                            |                                     |           |   |                                     |            |                         |                          |             |  |                          |              |   |

|   |                                   |
|---|-----------------------------------|
| Date of submission of the demand        | Date of completion of this report |
| Name and mailing address of the IPEA/EP | Authorized officer                |
| Facsimile No.                           | Telephone No.                     |

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/007077

Box No. I

Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language \_\_\_\_\_ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-36 \_\_\_\_\_ as originally filed/furnished
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☒ the claims:
- nos. 1-8 \_\_\_\_\_ as originally filed/furnished
- nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19
- nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ the drawings:
- sheets \_\_\_\_\_ as originally filed/furnished
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/007077

Box No. II

Priority

1. ☒ This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:
- ☒ copy of the earlier application whose priority has been claimed (Rule 66.7(a)).
- ☐ translation of the earlier application whose priority has been claimed (Rule 66.7(b)).
2. ☐ This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rule 64.1). Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/007077

**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

## 1. Statement

|                               |        |     |     |
|-------------------------------|--------|-----|-----|
| Novelty (N)                   | Claims |     | YES |
|                               | Claims | 1-8 | NO  |
| Inventive step (IS)           | Claims |     | YES |
|                               | Claims | 1-8 | NO  |
| Industrial applicability (IA) | Claims | 1-8 | YES |
|                               | Claims |     | NO  |

## 2. Citations and explanations (Rule 70.7)

Citations taken into consideration:

D2: EP-A-0 997 507 (AGFA GEVAERT NV) 3 May 2000  
(2000-05-03)

D3: US-A-6 080 816 (GREGOROVICH BASIL V ET AL.) 27  
June 2000 (2000-06-27)

D4: US-A-5 854 386 (HAYES JOHN E ET AL.) 29  
December 1998 (1998-12-29)

D5: US-B1-6 417 425 (ENGELHARDT FRITZ ET AL) 9  
July 2002 (2002-07-09)

D6: WO 01/00259 A (STOCKHAUSEN CHEM FAB GMBH;  
MESSNER BERNFRIED A (US); SUN FANG (US)) 4  
January 2001 (2001-01-04)

D7: US-B1-6 350 710 (JONAS GERD ET AL.) 26 February  
2002 (2002-02-26)

D8: WO 93/21237 A (DOW CHEMICAL CO) 28 October 1993  
(1993-10-28).

**1. Novelty (PCT Article 33(2))**

The present independent claim 1 discloses (meth)acrylic  
acid esters of alkoxyated unsaturated polyol ethers

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

containing at least three ethylenically unsaturated groups. This subject matter is not anticipated by any of the citations and thus is novel.

## 2. Inventive Step (PCT Article 33(3))

The closest prior is the citation D2, which differs from the subject of the application solely in the minimum number of three ethylenically unsaturated groups. However, there is nothing to indicate, nor was it stated, that the aforesaid distinguishing feature entails any special or unexpected effect.

The objective technical problem addressed by the present application is thus the preparation of alternative meth(acrylic) acid esters of alkoxyated unsaturated polyol ethers.

Each of documents D3 to D8 discloses clear-cut suggestions toward a solution of this problem by means of the aforesaid distinguishing technical feature (for the relevant passages cf. the international search report). Thus, before the priority date of the present application, a person skilled in the art had no problem, based on normal competence and expertise, in solving the above-cited objective problem by combining the indicated citations D2 or D3 to D8.

Consequently, the subject matter of the present application does not involve an inventive step in relation to a combination of documents D2 or D3 to D8.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/007077

Box No. VI Certain documents cited

1. Certain published documents (Rule 70.10)

| Application No.<br>Patent No. | Publication date<br>(day/month/year) | Filing date<br>(day/month/year) | Priority date (valid claim)<br>(day/month/year) |
|-------------------------------|--------------------------------------|---------------------------------|---|
|-------------------------------|--------------------------------------|---------------------------------|---|

2. Non-written disclosures (Rule 70.9)

| Kind of non-written disclosure | Date of non-written disclosure<br>(day/month/year) | Date of written disclosure<br>referring to non-written disclosure<br>(day/month/year) |
|--------------------------------|--|---|
|--------------------------------|--|---|

See Box V.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/007077

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Re Box VII see Box V.